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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/505,148	01/12/2005	Paul A Cameron	118989-04313564	5706

7590 06/21/2005

Mayer Brown Rowe and Maw  
Intellectual Property Department  
1909 K Street N W  
Washington, DC 20006-1101

EXAMINER
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COONEY, JOHN M

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 06/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/505,148

Applicant(s)

CAMERON ET AL

Examiner

John m. Cooney

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 0804.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The language "obtainable by" (rather than "obtained by") as well as such allied terms as "derivable from", "preparable from", etc. fails to particularly point out and distinctly claim the invention since one can not determine from the phrase just which compositions are "obtainable by" applicants' processes and which are not.

Claims 5-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 5-8 recite the limitation "process according to claim 1" in the 1<sup>st</sup> line. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Vinches et al.(4,602,079).

Vinches et al. disclose preparations of polyurethane elastomers having good hydrolysis resistance based on the reaction of polyisocyanate, polyester polyols derived from the reaction of dimer fatty acids and other acids such as adipic acid with polyols such as diethylene glycol, and chain extenders wherein, further, elastomers prepared from isocyanate-terminated prepolymers based on the described polyester polyols are reacted with chain extenders to form shaped articles including shoe soles (see column 1 lines 25-31, column 3 line 23 – column 7 line 63, the examples, and the entire document). Anticipation of the inventions of applicants' claims is evident based on the teachings of Vinches et al. Although the reference does not recite particulars of the properties of their products, it is held that the property values recited by applicants' claims are inherent to the teachings of Vinches et al. owing to the similarities in the materials employed. Anticipation of the quality of being a foam and, particularly, a microcellular foam is seen to be evident in the teachings of Vinches et al. owing to the similarities in the recitations of materials employed. Further, water is present in the feedstock employed in the making of the products of Vinches et al., and, accordingly, a degree of foaming necessary to meet the limitations of applicants' claims is seen to be evident.

The following is set forth as an alternative to the above rejection and is completely separate from the above rejection:

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vinches et al.('079) in view of Limerkens et al.(5,840,782).

Vinches et al. disclose preparations of polyurethane elastomers having good hydrolysis resistance based on the reaction of polyisocyanate, polyester polyols derived from the reaction of dimer fatty acids and other acids such as adipic acid with polyols such as diethylene glycol, and chain extenders wherein, further, elastomers prepared from isocyanate-terminated prepolymers based on the described polyester polyols are reacted with chain extenders to form shaped articles including shoe soles (see column 1 lines 25-31, column 3 line 23 – column 7 line 63, the examples, and the entire document).

Vinches et al. differs from the claims in that foam formation is not particularly recited. However, Limerkens et al. recites employment of water in the making of related polyurethane microcellular foams used in shoe soling applications for the purpose of imparting the foaming effect (see column 3 line 65 – column 4 line 24, as well as, the

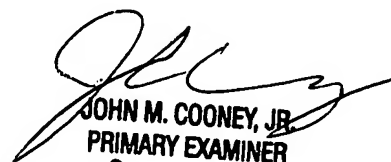
entire document). Accordingly, it would have been obvious for one having ordinary skill in the art to have employed water in the manner taught by Limerkens et al. in the preparations of Vinches et al. for the purpose of imparting its foaming effect in order to arrive at the products and processes of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lemper et al., Santanello, and Daley et al. are cited for their disclosure of background to the instant invention and related disclosures.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
JOHN M. COONEY, JR.  
PRIMARY EXAMINER  
*Group 1700*